

Attorney's Docket No.: 00501-024001 / M1-805PCT-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kohsuke Kino et al.
Serial No. : 09/202,464
Filed : December 14, 1998
Title : T-CELL EPITOPE PEPTIDES

Art Unit : 1644
Examiner : P. Huynh

Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Office Action mailed March 9, 2001, Applicants provisionally elect the claims of Group 1 (claims 1, 3, and 5) as they relate to a peptide with SEQ ID NO:24. The election is made with traverse. In addition, Applicants cancel claims 18 and 19 without prejudice to their being prosecuted in a separate application.

Reasons for traversal of restriction requirement

The Examiner indicates on page 3, lines 23-29, of the Office Action that the claims of groups VI-X lack a special technical feature that defines the contribution of the instant invention over Ikagawa et al. (J. Allergy Clin. Immunol. 97(1):53-64, 1996). Applicants point out that Ikagawa et al. discloses peptides (and analogs thereof) derived from Cry 1 j, which is a polypeptide of Japanese cedar pollen, but neither discloses or even suggests peptides (and analogs thereof) derived from Cha o 1 and Cha o 2, which are polypeptides of Japanese cypress pollen. Hence, the peptide analogs (and methods of making them) specified by the claim groups VI- VII and IX-X cannot be rendered obvious by Ikagawa et al. Furthermore, Applicants do not understand why the Examiner has included the claim of group VIII (claim 21, drawn to a method of diagnosis that involves the use of the peptides of claim 2 and not the use of peptide analogs) in the claim groups she believes to be rendered obvious by Ikagawa et al. Furthermore, while the

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Examiner cited the disclosure of Ikagawa et al. as the basis for the alleged lack of same or corresponding special technical features in claim groups VI-X, she has provided no basis for her belief that claim groups I-V and XI-XII also lack a common or corresponding special technical feature. In summary, Applicants submit that the Examiner has failed to provide a basis for her assertion that claim groups I-XII do not relate to a single general inventive concept. Applicants submit that the claims of groups I-XII do share a common technical feature in that they specify peptides (native, analogs, or modified) that are useful for treating allergy to Japanese cypress pollen and methods of using or making such peptides and thus relate to a single general inventive concept.

In addition, Applicants respectfully submit that the Examiner's requirement for an election of species is improper. The instant application is a "Rule 371" application and is thus subject to PCT rules for "unity of invention" and not to the U.S. rules of restriction practice. The Examiner asserts, as a basis for her requirement for election of a species, that each of the amino acid sequences within the Markush groups of claims 1 and 2 is a "patentably distinct" species. She bases this assertion on the fact that the various amino acid sequences are different compounds that differ with respect to their structure and biochemical properties. However, distinct patentability is a ground for restriction under U.S. law, not under the PCT rules for unity of invention. The proper test for unity of invention (under PCT rules) is that the claims share a common special technical feature that distinguishes the invention over the prior art. For the reason given above, the claims of all groups share such a common technical feature, i.e., they specify novel, unobvious peptides (native, analogs, or modified) that are useful for treating allergy to Japanese cypress pollen and methods of using or making such peptides.

In light of the above considerations, Applicants request that all the pending claims be examined in their entirety in the instant application.

In the event that the Examiner is unwilling to consider all the pending claims in the present application, Applicants request that, at least, claims relating to Cha o 1 peptides (i.e., those in present claim groups I, III, V, VI, VII, and XI) be considered in one application and claims relating to Cha o 2 peptides (i.e., those in present claim groups II, IV, VIII, IX, X, and XII) be considered in a second application.

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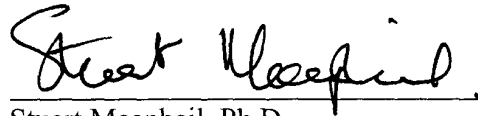
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Enclosed is a request for an automatic extension of time and a check in payment of this extension of time. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

9/7/01



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